REMARKS

Applicants submit that this Amendment presents claims in better form for consideration on appeal. Moreover, applicants submit that this Amendment responds to at least one argument that was first presented in the Office Action mailed September 9, 2005. Applicants submit that there is good and sufficient reason why this Amendment is necessary, why this amendment was not earlier presented, and why this amendment should be admitted now. Furthermore, applicants believe that consideration of this amendment could lead to favorable action that would remove one or more issues for appeal.

Office Action Rejections Summary

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claim 1, 9 and 12 have been rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter.

Claims 5-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,329 of Meyer ("Meyer") in view of U.S. Patent No. 5,586,304 of Stupek Jr. et al. ("Stupek").

Claims 1-4 and 9-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek, as applied to claims 5-8, and further in view of U.S. Patent No. 6,360,363 of Moser et al. ("Moser").

Status of Claims

Claims 1-17 are pending in the application. Claims 1 and 13 have been amended to present the claims in better form for consideration on appeal. No new matter has been added. No claims have been added and no claims have been cancelled.

Examiner Interview Summary

The applicants thank the Examiner for the courtesy of two telephone interviews conducted on March 3, 2006 with applicants' representative, Richard Thill (Reg. No. 53,686). The purpose of the interviews was to clarify the basis of the 35 USC 101, 112 and 103 rejections in the Office Action mailed September 9, 2005 ("Office Action").

The Examiner was first asked to explain the rejections of independent claims 1, 9 and 13 under 35 USC 112, second paragraph (applicants' representative noted that the text of the rejection erroneously refers to claim 12, rather than claim 13, and the Examiner acknowledged that "12" was a typographical error). The second paragraph of section 112 requires that "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." However, claims 1, 9 and 13 were rejected for "insufficient antecedent basis in the claim" for the "limitations," "a method comprising" in claim 1, "an apparatus for updating a message . . . comprising" in claim 9 and "an apparatus comprising," 13. When asked how the preamble of an independent claim could lack antecedent basis, the Examiner stated that what he meant by "insufficient antecedent basis in the claim" was that he believed the limitations in the bodies of the claims lacked an antecedent in the specification. Applicants' representative pointed out that a rejection for lack of antecedent basis in the specification is a 35 USC 112, first paragraph rejection,

not a second paragraph rejection. Nevertheless, applicants' representative referenced specific locations in the specification that support each claim. The Examiner invited the applicants' to make the same arguments in a written response to the Office Action.

The Examiner was next asked to explain the rejections of independent claims 1, 9 and 13 under 35 USC 101 for non-statutory subject matter. The Examiner stated that the subject claims are non-statutory because they are computer-related processes that produce no tangible result. Applicants' representative pointed out the tangible results disclosed in the specification and that such tangible results, even if not explicit in the claims, would be appreciated by one skilled in the art from reading the claims in light of the specification. The Examiner invited the applicants to make such arguments in a written response to the Office Action.

Finally, with respect to the 35 USC 103 rejections of claims 1-17, applicants' representative pointed out that the Office Action was non-responsive to at least one of the applicants' arguments in a response filed on June 14, 2005 with respect to rejections under 35 USC 103(a). The Examiner invited the applicants to cite the failure to respond and resubmit the argument in a written response.

Claim Rejections - 35 U.S.C. §112, Second Paragraph

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

As discussed above, during a telephone interview on March 3, 2006, the Examiner cited a lack of support in the specification as the basis for the Section 112, second

paragraph rejections. Applicants submit that the statutory basis for the rejections cited in the Office Action is improper because the substance of the rejections fall under either the written description or enablement requirement of 35 USC 112, first paragraph. However, in an effort to expedite the allowance of the subject claims, applicants respond herein to the substance of the rejections, irrespective of the statutory basis cited in the Office Action.

Applicants remind the Examiner that "The subject matter of the claim[s] need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." MPEP 2163.02. Furthermore, the original claims, as filed, constitute part of the specification: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 USC 112, second paragraph. Applicants submit that all of the limitations in the claims, as presently amended, were present in the application as filed and, therefore, are self-supporting.

Additionally, "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. MPEP 2163.04 (*citing, In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. MPEP 2163.05 (*citing, Wertheim*, 541 F.2d at 263, 191 USPQ at 97). Applicants submit

that the Examiner has not met his initial burden. Nevertheless, applicants offer the

following observations and arguments to assist the Examiner in identifying support for

the subject claims in the specification.

Claim 1, recites:

> A method for upgrading a database, comprising:
>   updating a message from a first version to an upgraded version by
> chaining through intermediate versions, wherein updating comprises:
>   receiving an update message having a first version format; and
>   repeatedly generating a revised update message having a next most
> recent version format based on the update message until a final update
> message having an upgraded version format is generated.

Applicants submit that support for claim 1 may be found in the specification at

least on page 4, lines 10-16, page 7, lines 13-21 and page 12, line 3 through page 16, line

1 (including Figures 2a-2d and Figure 3). Applicants submit that the cited passages

demonstrate that the applicant's were in possession of the claimed invention as of the date

of the invention, MPEP 2106(V)(B)(1), and that the specification enables a person skilled

in the art to make and use the claimed invention, MPEP 2106 V.B.(2). Accordingly,

applicants respectfully request that the rejection of claim 1 under 35 USC 112 be

withdrawn.

Claim 9 recites:

> An apparatus for updating a message from a first version to an upgraded
> version by chaining through intermediate versions comprising:
>   means for receiving an update message having a first version format;
> and
>   means for repeatedly generating a revised update message having a
> next most recent version format based on the update message until a final
> update message having an upgraded version format is generated.

Claim 9 is a means plus function claim. "A means plus function limitation is distinctly claimed if the description makes it clear that the means correspond to well-defined structure of a computer or computer component implemented in either hardware or software and its associated hardware platform." MPEP 2106 V.A.(2) (*citing Atmel Corp. v. Information Storage Devices Inc., 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999); B. Braun Medical Inc. v. Abbott Labs., 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).*

Applicants submit that the written description makes clear such correspondence at least in page 9, line 20 through page 12, line 2, in combination with Figure 1. Accordingly, applicants respectfully request that the rejection of claim 9 under 35 USC 112 be withdrawn.

Claim 13, recites:

> An apparatus for upgrading a database, comprising:
>   a network switching device to receive an update message having a first version format; and,
>   a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions, the controller card to repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

Claim 13 is an apparatus claim reciting structure including a network switching device and a controller card. Applicants submit that support for the claimed structure may be found in the specification at least in Figure 1, on page 9, line 21 and on page 11, lines 3-5. Accordingly, applicants respectfully request that the rejection of claim 13 under 35 USC 112 be withdrawn.

Claim Rejections – 35 U.S.C. §101

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §101 as being directed to

non-statutory subject matter. The Office Action states:

> A claim that requires one or more acts to be performed defines a process.
> However, not all processes are statutory under 35 U.S.C. 101. Schrader,
> 22 F.3d at 296, 30 USPQ2.d at 1460. To be statutory, a claimed
> computer-related process must either: (A) result in a physical
> transformation outside the computer for which a practical application in
> the technological arts is either disclosed in the specification or would
> have been known to a skilled artisan, or (B) be limited to a practical
> application within the technological arts.(MPEP 2106 IV.B.2.(b))

(Office Action, 9/9/05, p. 3).

The Office Action further states that claims 1, 9 and 13 are non-statutory because

they merely recite a number of computing steps without producing any tangible result

and/or being limited to a practical application within the technological arts (9/9/05 Office

Action, p. 3).

Applicants submit that the rejection of claims 1, 9 and 13 are improper because

each of the rejected claims achieves at least the **practical application of upgrading a**

database, which application is either explicit in the claim or implicit from the written

description, and would be understood by one of ordinary skill in the art. Accordingly,

applicants respectfully request that the rejections of claims 1, 9 and 13 under 35 USC 101

be withdrawn.

Claim Rejections – 35 U.S.C. §103(a)

Claims 5-8 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek. Claims 1-4 and 9-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek, as applied to claims 5-8, and further in view of Moser.

Applicants note that the Office Action repeats the rejections of claims 1-17 from the previous Office Action (mailed September 9, 2005), without addressing all of the applicants' arguments in the response filed on June 14, 2005. In particular, the Examiner has not responded to applicants' arguments that beyond the failure of the cited references to teach or suggest all of the limitations of the subject claims, there is no motivation to combine the cited references.

The applicants respectfully direct the Examiner's attention to MPEP §707.07(f), which states, in part: "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The applicants respectfully request that the Examiner respond to all of the applicants' arguments.

Claim 5 recites:

> An article of manufacture comprising a computer readable medium having instructions stored thereon, which when executed by a data processing system, causes the data-processing system to perform a method, comprising:
> receiving an update message having a first version format; and
> **generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

The Office Action concedes that "Meyer does not explicitly disclose repeated generation of a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated." (Office Action, 9/9/05, page 4, lines 10-12). The Office Action goes on to state:

> However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notified that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions.

(Office Action, 9/9/05, page 4, lines 12-18).

The Office Action makes an omnibus citation to Stupek (127 lines), yet is unable to point, with specificity, to an express or implied suggestion in Stupek that provides the limitation missing from Meyer. In fact, the disclosure of Stupek pointed to by the citation is a *non sequitor* with respect to the limitations of claim 5. Therefore, it is submitted that Meyer and Stupek, either alone or in combination, do not teach or suggest the subject limitation.

The Office Action then falls back on the alleged person of ordinary skill in the art, stating:

> It would have been obvious to a person of ordinary [skill] in the art at the time the invention was made to modify the combined teachings of Meyer and Stupek with generating repeatedly a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining . . . . (see col. 2, lines 42-44).

(Office Action, 9/9/05, page 4, lines 18-24).

The Office Action asserts that one skilled in the art would be motivated to modify the combined teachings of Meyer and Stupek with the missing limitation to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining. This reasoning is circular and reflects the use of impermissible hindsight, based on the applicants' own disclosure. As noted above, Meyer and Stupek, either alone or in combination, do not teach or suggest the missing limitation. Furthermore, neither Meyer nor Stupek are concerned with the problem of release chaining. Both Meyer and Stupek are concerned with updating one or more prior versions of data or computer resources **directly** to a current version without intermediate chaining. (Meyer, col. 4, lines 42-44; Stupek, col. 1, lines 56-62). The Office Action provides no evidence why such a modification to the combination of Meyer and Stupek would lead to the purported improvement in accuracy.

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or **the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.**" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (emphasis added).

Applicants respectfully submit that in merely asserting a nebulous benefit of "improved accuracy" without a convincing line of reasoning, the Examiner has not met his burden of proof.

Furthermore, applicants submit that the proposed modification of the prior art is improper because the proposed modification would change the principle of operation of the references.

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

As noted above, the principles of operation of both Meyer and Stupek both rely on direct updating from one or more prior versions of data or software to a current version **to avoid intermediate chaining**. Modifying either Meyer or Stupek to implement release chaining through intermediate versions, as suggested by the Office Action, would alter the basic principles of operation of the references. Therefore, the proposed modification is improper.

Therefore, for at least the reasons discussed above, applicants submit that claim 5 is patentable over Meyer in view of Stupek. Given that claims 6-8 depend from claim 5, it is submitted that claims 6-8 are also patentable over the cited references.

Claims 1-4 and 9-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer in view of Stupek, as applied to claims 5-8 above, and further in view of Moser.

Claim 1 recites:

A method comprising:
     updating a message from a first version to an upgraded version by chaining through intermediate versions, wherein updating comprises:
          receiving an update message having a first version format; and
          repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.

(emphasis added)

Claim 9 recites:

> An apparatus for updating a message from a first version to an upgraded version by chaining through intermediate versions comprising:
>
>   means for receiving an update message having a first version format; and
>
>   means for **repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

Claim 13 recites:

> An apparatus comprising:
>
>   a network switching device to receive an update message having a first version format; and,
>
>   a controller card to **update a message from a first version to an upgraded version by chaining through intermediate versions**, the controller card to **repeatedly generate a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated.**

(emphasis added)

The Office Action states:

> While Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21).

(Office Action, 9/9/06, page 6, lines 11-16).

Applicants refer the Examiner to the discussion above with respect to the proposed combination of Meyer and Stupek. With respect to Moser, applicants submit

that the Office Action mischaracterizes the teachings of Moser. Moser discloses combining an old version of a program with a new version of the program in a temporary intermediate version of the program that contains both the old version of the program and the new version of the program. (Moser, col. 3, lines 12-14). That is, the updated version of the program in Moser already exists when the intermediate version is created.

Combining an existing updated version of a program with an old version of the program to create an intermediate version of the program is not the same as "repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated" as recited in claims 1, 9 and 13, or "updating a message from a first version to an upgraded version by chaining through intermediate versions," as recited in claims 1 and 13.

Therefore, in view of the foregoing arguments, applicants submit that Meyer, Stupek and Moser, either alone or in combination, do not teach or suggest the subject limitations and that claims 1, 9 and 13 are patentable over the cited references. Given that claims 2-4 depend from claim 1, that claims 10-12 depend from claim 9 and that claims 14-17 depend from claim 13, it is submitted that claims 2-4, 10-12 and 14-17 are also patentable over the cited references.

Conclusion

In conclusion, applicants respectfully submit that in view of the arguments set forth herein, the applicable rejections have been overcome.
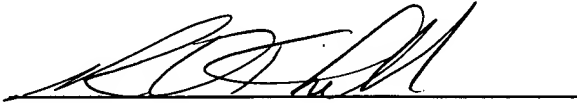
If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Richard Thill at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 3 - 8 , 2006

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